

REMARKS

This paper is presented in response to the non-final official action dated March 30, 2006, wherein: (a) claims 1-8, 10-12, 14-21, and 23-28 are pending; (b) all of the pending claims were rejected as being based upon a defective reissue declaration under 35 USC § 251; (c) claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27, and 28 were rejected under 35 USC § 102(b) as being anticipated by Smith et al. U.S. Patent No. 5,403,605 ("Smith"); (d) claims 2, 3, 6, 19, 20, and 26 were rejected under 35 USC § 103(a) as being obvious over Smith in view of Krebs U.S. Patent No. 4,052,318 ("Krebs"); and, (e) claims 5, 11, 15, 24, and 25 were rejected under § 103(a) as being obvious over Smith.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the 1st month, and payment of the required extension fee.

Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

I. Revised Supplemental Reissue Declaration

A revised supplemental reissue declaration with references to the instant application inserted where appropriate is submitted herewith, and it is requested that the rejection based upon the declaration be withdrawn.

II. The 35 USC § 102(b) Rejection Is Traversed

Claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27, and 28 were rejected under 35 USC § 102(b) as being anticipated by Smith. See p. 3 of the action.

A. Proper Basis for a § 102(b) Rejection

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Additionally, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

B. The § 102(b) Rejection Is Traversed

It is respectfully submitted that pending claims 1, 4, 7, 8, 10, 12, 14, 16-18, 21, 23, 27, and 28 are not anticipated by Smith.

Smith discloses a coffee filter as part of a coffee brewing method. With respect to its disclosed coffee brewing apparatus, Smith incorporates by reference the disclosure of the concurrently filed, copending application to Smith, Herrick, and Bruncaj. See Smith, col. 2, line 61 to col. 3, line 2. This incorporated disclosure issued as Herrick et al. U.S. Patent No.

5,190,653 ("Herrick").¹ The filter includes a foraminous support sheet, preferably made of stainless steel, which support sheet provides the strength needed to support the filter element located above the support sheet. See Smith, col. 4, lines 38-41. The holes of the support sheet range from 1 mm to 2.5 mm in diameter. See Herrick, col. 3, lines 29-30. The coffee used in the disclosed method has an average particle size between 300 μ m and 850 μ m, and the Example presents four runs having average particle sizes of 600 μ m and 780 μ m. See Smith, col. 3, lines 30-33 and col. 5, line 12.

Independent claim 1 recites "a permanent filter in said path of heated coffee passing to the receptacle which filter has openings sized to filter out the fine espresso coffee grounds." The support sheet of Smith has openings of at least 1 mm, and the coffee grind of Smith has a maximum average particle size of 850 μ m. Thus, the support sheet of Smith is incapable of filtering anything except the coarse tail of a conventional coffee size distribution, and certainly is incapable of filtering fine espresso coffee grounds (which have a maximum particle size of 300 μ m; see Hilbrich U.S. Patent No. 6,016,740, col. 1, lines 10-19).

Independent claims 4, 7, 17, and 21 recite "finely ground coffee." Dependent claims 12 and 16 further recite that the "finely ground coffee has grounds of 0.3 mm or less in particle size." Smith discloses a brewing apparatus for a conventional coffee grind and discloses neither finely ground coffee nor a type of coffee that is typically finely ground (e.g., espresso). Furthermore, the disclosed size distributions of Smith have a minimum average particle size of 300 μ m, and any such size distribution necessarily has at least some particles larger than 300 μ m. Dependent claims 12 and 16 require the finely ground coffee (i.e., espresso) to have a maximum particle size of 300 μ m (i.e., 0.3 mm). Thus, Smith fails to disclose finely ground coffee in general and fails to disclose a coffee grind having the recited size distribution.

Because none of the five independent claims (1, 4, 7, 17, and 21) are anticipated by Smith, reconsideration and withdrawal of the § 102(b) rejections are requested.

III. The 35 USC § 103(a) Rejection Is Traversed

Claims 2, 3, 5, 6, 11, 15, 19, 20, and 24-26 were rejected under 35 USC § 103(a) as being obvious over the combination of Smith and Krebs or over Smith alone. See pp. 3-5 of the action.

A. Proper Basis for a § 103(a) Rejection

To establish a *prima facie* case of obviousness, the PTO must satisfy three basic criteria. First, the combined disclosure of the prior art references must teach or suggest all of

¹ Herrick issued from Application No. 07/606,040, filed October 30, 1990. Smith issued as a continuation of Application No. 07/606,041, filed October 30, 1990.

the claim limitations. Second, there must be some suggestion or motivation to modify or combine the teachings in the art to make the precise combination recited in the claims. Finally, a person having ordinary skill in the art must have a reasonable expectation of success when combining or modifying the disclosures of the references. The suggestion or motivation to make the claimed invention and the reasonable expectation of success must both be derived from the prior art, and not from the application's disclosure. See MPEP §§ 2142-43 (8th ed., October 2005).

**B. No Prima Facie Case of Obviousness Has Been Made
and, therefore, the § 103(a) Rejection Is Traversed**

It is respectfully submitted that pending claims 2, 3, 5, 6, 11, 15, 19, 20, and 24-26 are not obvious over the combination of Smith and Krebs or over Smith alone.

Krebs is directed to a mesh coffee filter. Krebs discloses a filter having multiple layers and is not relevant to the recited features relating to filter opening size, finely ground coffee, and coffee grind particle size distribution. Therefore, Krebs fails to remedy the deficiencies of Smith taken alone (see Section II.B above), and any combination of Smith and Krebs fails to teach or suggest all of the claim limitations.

Further, there is no motivation to modify Smith to remedy the above deficiencies. As noted above, Smith makes no mention of any type of coffee being finely ground or having a maximum particle size of 0.3 mm. In describing the problem to be solved of providing high quality coffee in short brewing times, Smith notes that the brewing parameter "fineness of grind . . . [has] not to date enabled the high quality expected and achievable by simply dripping hot water through roasted and ground coffee held in a paper filter." See Smith, col. 1, lines 12-22. Smith, therefore, pursued an alternate method of improving coffee quality/brewing time, which alternate method included a steam pre-treatment of the coffee grounds prior to hot water extraction. See Smith, at abstract. Thus, the skilled artisan would not be motivated to reduce or vary the particle size distributions disclosed in Smith.

Similarly, the foraminous support sheet of Smith is intended to act as a support for the filter element, and not as a filter element itself. See Smith, col. 4, lines 38-41. Consistent with this function, Herrick instructs that the support sheet "should contain the maximum open area consistent with strength." See Herrick, col. 3, lines 25-27. Thus, the skilled artisan would not be motivated to reduce the diameter of the holes in the support sheet (i.e., so that the support sheet would be capable of filtering fine espresso coffee grounds), because such a modification would reduce the open area of the support sheet and restrict the through-flow of brewed coffee.

Accordingly, reconsideration and withdrawal of the § 103(a) rejections are respectfully requested.

CONCLUSION

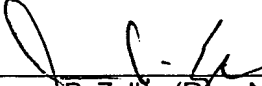
In view of the foregoing, reconsideration and withdrawal of the rejections, and allowance of claims 1-8, 10-12, 14-21, and 23-28 are respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

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